



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,439	11/16/2000	Shelton Louie	1205-002/JRD	5706
21034	7590	09/21/2005	EXAMINER	
IPSOLON LLP 805 SW BROADWAY, #2740 PORTLAND, OR 97205			MCCLELLAN, JAMES S	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,439

Applicant(s)

LOUIE ET AL.

Examiner

James S. McClellan

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Reconsideration

1. Applicant's submittal of an amendment was entered on 7/12/05, wherein: claims 1-61 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-39, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,464,142 (hereinafter "Denenberg") in view of U.S. Patent No. 6,496,806 (hereinafter "Horwitz").

Denenberg et al disclose a method for taking prescription orders through a retail pharmacy having a plurality of spaced apart locations comprising the steps of receiving the prescription order at a first location upstream of a will call storage area (col. 9, lines 64 through col. 10, line 4); entering data into a computer system at a second location (16); tagging a carrier of the prescription order with a barcode (col. 6, lines 30-38)., manually storing the filled prescription at one of a plurality of storage locations having a plurality of cubbies (14, 18, 20); detecting the prescription order at one of the plurality of storage locations with a barcode reader (col. 8, lines 46-50); recording the location of the prescription order (col.

Art Unit: 3627

6,1 lines 39-47); and displaying the location on a computer display (col. 13, lines 27-47).

Denenberg et al further disclose the steps of automatically collecting timing information, storing the timing information, and compiling workflow information based on the timing information (col. 16, lines 1-43). A worker can be automatically signaled when the prescription order exceeds a predetermined amount of time (col. 16, lines 30-43). The workflow information may be associated with a particular worker to evaluate worker efficiency (col. 16, lines 2-5).

Denenberg et al do not disclose a tag that is detachably secure to the prescription order or that is rigidly secured to the prescription. However, detachable and rigidly secure tags are both common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a rigidly secured tag with the invention of Denenberg et al to ensure that the tags aren't mistakenly lost. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a detachable tag with the invention of Denenberg et al, so that the tags may be re-used.

Denenberg does not teach the step of detecting the presence of the prescription order at a first station upstream of a storage area. Horwitz et al teach the use of an RFID tag and reader for locating items (see Fig. 4). Horwitz et al teach the step of detecting the presence of an item at a first station (124) and tracking the item upstream of a storage area (108). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the system of Horwitz with the invention of Denenberg to help individuals locate prescriptions or prescription information anywhere within the pharmacy.

Art Unit: 3627

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Horwitz as applied to claim 1 above, and further in view of U.S. Patent No. 4,766,542 (hereinafter "Pilarczyk").

Denenberg and Horwitz teach all of the limitations of the claim except for a teaching of notifying a pharmacy worker if a refill prescription has been prematurely submitted.

Pilarczyk teaches a system for prescription compliance that notifies a worker if a refill has been submitted prematurely (col. 10, lines 5-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Pilarczyk with the combination of Denenberg and Horwitz so that a pharmacist may make note of premature refills.

5. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Horwitz as applied to claim 31 above, and further in view of U.S. Patent No. 5,926,093 (hereinafter "Bowers").

Denenberg in combination with Horwitz disclose all the claim limitations as set forth above, but fail to explicitly disclose the use of a tag reading employing a switching device.

Bower teaches the use of RFID tag reading employing a switching device (see paragraph bridging columns 10-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Denenberg/Horwitz with the switching device as taught by Bowers, because using a switching device is more efficient (see Abstract).

6. Claims 44-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Isaacman.

Denenberg teaches all of the limitations as Claims 44-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over described in paragraph 3 of this Office Action.

Denenberg does not teach a tag reader for each cubby or that items are placed in a cubby without indication from a computer system.

Isaacman teaches a tracking system with an RFID tag and reader (see Fig. 3). Isaacman et al teach that an item can be placed on any shelf or in any drawer without indication from a computer system, and the items will be tracked (see Abstract; Fig. 4, col. 4, lines 45-53; and col. 8, line 61 through col. 9, line 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Isaacman et al with the invention of Denenberg et al to track items in drawers without indication from a computer system to reduce human error.

Response to Arguments

7. Applicant's arguments filed July 12, 2005 have been fully considered but they are not persuasive.

On page 14, 5th paragraph, Applicant argues "NO references of record teach or suggest using this combination of hardware in a retail pharmacy for these purposes." In paragraph #4 of the same page, Applicant identifies the hardware combination as RFID tags and multiplexed tag readers. Despite the fact that said hardware combination appears to be the key feature of Applicant's invention (according to Applicant's arguments), neither RFID tags nor multiplexed tag readers are required by any of the independent claims. Although RFID tags are claimed in

Art Unit: 3627

dependent claims, Applicant also claims bar code tags and bar code tag readers in claim 11. In fact, Applicant doesn't appear to even claim "multiplex tag readers" in any of the claims.

Despite Applicant arguing limitations not found in the claims, the combination of Denenberg et al. teaches monitoring/tracking pharmaceuticals via bar codes and Horwitz et al. teaches tracking items via RFID tags.

On pages 14-15, Applicant identifies seven limitations from various claims that Applicant alleges is not taught by the current rejections. The Examiner respectfully disagrees. First, Denenberg teaches "automatically detecting the presence of a specific filled prescription order" (see column 8, lines 46-50). The use of a scanner "automates" the detection. Additionally, Deneberg uses an article sensor (23; see column 7, lines 42-53). Second, Deneberg discloses "automatically associates that specific filled prescription order with a customer" (see column 10, lines 5-27). Third, Horwitz teaches automatically tracking upstream movement of an item as it moves through a facility (see steps in Figure 6). Fourth, Deneberg discloses "automatically evaluating working performance based on detected timing information compiled by the computer system" (see column 16, lines 2-5). Fifth, Deneberg discloses "automatically verifying that a pharmacy worker has removed the correct prescription order for a particular customer (see column 13, lines 27-35). Sixth, Deneberg discloses "automatically signaling a pharmacy worker if an incorrect prescription order is about to be dispensed to a customer, before it is actually dispensed to that customer (see column 15, lines 50-67). Seventh, Denenberg system "allows" a pharmacy worker to select any storage area because there is nothing that expressly prevent a worker from placing an order in any give storage area.

Art Unit: 3627

In response to applicant's argument on page 16, first full paragraph, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is clearly set forth above for each 35 U.S.C. § 103 rejection.

On page 16, third full paragraph, Applicant argues that neither Denenberg not Horwitz disclose verifying that the correct prescription order has been dispensed to the correct customer. In addition to column 10, lines 5-18 and 37-62, Denenberg disclose verifying a correct order in column 15, lines 50-67.

On page 16, final paragraph, Applicant argues that "Obviousness" is not adequate grounds to reject secondary considerations. The secondary considerations were considered but very little evidence was supplied to support Applicant's argument of secondary considerations. For example, commercial success was not supported with facts. Applicant's statement merely alleges that the company is viable and competitive. Additionally, Applicant provided little to no facts regarding "Evidence of Copying". Applicant's request for secondary consideration may be reconsidered once Applicant provides facts to support the secondary considerations.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

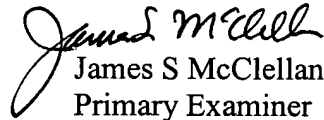
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. McClellan whose telephone number is (571) 272-6786. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3627

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James S McClellan
Primary Examiner
Art Unit 3627

jsm
9/19/05